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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,149	10/12/2000	John J. Sie	19281-000900US	8623

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EXAMINER

BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/687,149

Applicant(s)

SIE ET AL.

Examiner

Reuben M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 18-20, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-20, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 of the present application, 09/687,149, hereinafter referred to as '149 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 & 20 of copending Application No. 09/687,148, hereinafter referred to as '148. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 & 20 of the amended '148 application contains all of the elements of the present application, '149.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Considering claim 1 of the present application, the claimed method for distributing programming, the method comprising:

‘transmitting a first set of programs in real time according to a schedule of programming’ and ‘storing a second set of programs on a server, at least one of the first set of programs having a counterpart in the second set of programs’, is recited verbatim in claim 1 of the the ‘148 application.

The amended claimed feature of, ‘located on a set-top box local to a user’ is recited verbatim in claim 20 of the ‘148 application. The additionally amended claimed feature of ‘wherein the counterpart in the second set of programs is substantially identical to the at least one of the first set of programs’ is also recited verbatim in the amended claim 1 of the ‘148 application.

The further claimed feature of ‘playing at least one of the second set of programs from the server under the control of the user’, corresponds directly with the feature recited in claim 1 of the ‘148 application, which reads ‘each of which is configured to be played under the user’s control’.

Therefore the claims 1 & 20 of the ‘148 application contains all of the elements of claim 1 of the present application, ‘149. However, claim 1 of the ‘148 includes the additional feature, not recited in the claim 1 of the ‘149 application, namely, ‘transmitting a notification signal to

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distinguish at least one of the second set of programs on the server from programs not on the server’.

Therefore, the Examiner turns to Garfinkle, which is in the same field of endeavor, which provides a teaching of storing a lead-in segment of movies at a local set-top box, which corresponds with the claimed ‘second set of programs on a server located on a set-top box, local to a user’. Garfinkle goes on to teach that along with the listing of video products, there is an indication also transmitted, which indicates whether a particular movie stored in the video product store 12 has a corresponding lead-in or trailer also stored in the catalog memory store 22/product store 24, see col. 3, lines 40-64 & col. 4, lines 1-64. It would have been obvious for one of ordinary skill in the art the time the invention was made, to modify claim 1 of the ‘149 application, with the teachings of Garfinkle indicating whether a particular movie from the menu catalog has a lead-in segment stored on the local user’s set-top box, at least for the desirable advantage of informing the instant user of which movies from the video product store 12 have a lead-in or trailer downloaded and stored at the user’s set-top box.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 11, 13-14, 18-19 & 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle, (U.S. Pat # 5,530,754), in view of Proehl, (U.S. Pat # 6,532,589) and Gordon, (U.S. Pat # 6,510,554).

Considering claim 1, the amended claimed method for ‘distributing programming comprising transmitting a first set of programs in real time’, reads on the discussion of Video On Demand, in Garfinkle that upon request from a user, the central station 10 transmits the movie to the instant user site 18, see Fig. 1; col. 2, lines 8-12; col. 3, lines 25-31; col. 5, lines 1-18. The ‘first set of programs’ corresponds with the movies that are stored in the product store 12 at the central station 10, col. 2, lines 39-55; col. 4, lines 35-46.

As for the specific feature that the ‘first set of programs are transmitted in real time according to a schedule of programming’, Garfinkle only discusses displaying the list of programs as a menu/catalog, not as a ‘schedule of programming’. However, Proehl teaches that a first set of programs (which reads on the entire schedule of programs) is transmitted to the subscriber as an EPG, (Fig. 7; col. 4, lines 10-12). It would have been obvious for one of

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ordinary skill in the art at the time the invention was made, to modify Garfinkle with the teachings of Proehl (col. 1, lines 54-67), presenting the 'first set of programs to the subscriber as a schedule of programs', at least for the desirable advantage of providing the subscriber with the option of accessing one or more programs at specific predetermined times, i.e. when they are broadcast; which Proehl furthermore suggests would have been a desirable improvement, of integrating the old art of EPG, with the technology used in record and playback functions of video data recorders, col. 6, lines 61-67.

Regarding the amended claimed 'second set of programs stored on a server, located on a set-top box local to the user, such that at least one of the first set of programs has a counterpart in the second set of programs', in Garfinkle the video products that are downloaded and stored at the catalog memory store 22/ product store memory 24 are sent from the video product store 12, located at the central station, Abstract; col. 3, lines 5-20 & col. 4, lines 1-12. Therefore the movies (i.e., lead-in or trailer) stored in the catalog memory store 22/product store memory 24, represent a subset of programs stored in the video product store 12, and thus read on the claimed, 'second set of programs'.

As for the further claimed feature of the 'second set of programs having a counterpart substantially identical to the at least one of the first set of programs', all of the lead-in programs stored in the user's receiver in Garfinkle have a counterpart on server, i.e. first set of programs. Thus combining Garfinkle with Proehl would provide the schedule of programs broadcast that a

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viewer could choose from, while once the selection is made, the lead-in segment is automatically played until the remainder of the program is downloaded to the viewer.

As for the specific recitation that 'each of the second set of programs is configured to be played under a user's control', Garfinkle does not discuss the use of trick-play technology when playing the movies. Nevertheless Baker, which is in the same field of endeavor of VOD technology, teaches the old art of VCR-like controls of a movie transmitted to a user, from a remote server, col. 6, lines 15-35; col. 12, lines 10-20; col. 14, lines 21-67 thru col. 15, lines 1-10, using standard trick-play functions such as Rewind, Pause, Fast Forward. It would have been obvious for one of ordinary skill in the art at the time the invention as made, to modify Garfinkle with the old art, using the trick-play technique for the known desirable benefit of allowing the subscriber to view movies with the same control features of a standard VCR system, as taught by Baker, col. 1, lines 35-65; col. 2, lines 10-25; col. 3, lines 15-31 & col. 3, lines 39-44.

Considering claim 2, the claimed feature of, 'wherein playing at least one of the second set of programs from the server under control of the user comprises switching from transmission of a particular program according to schedule of programming to transmission of a counterpart to the particular program', reads on the discussion in Garfinkle that when a movie is selected from the catalog, that the system determines if the instant movie has a lead-in segment stored on the user's set-top box, and if so (at least initially), the user's TV displays the movie from the lead-in segment, instead of from the server, (col. 4, lines 51-67 thru col. 5, lines 1-15 & Fig. 5).

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Considering claim 3, the claimed 'processing a program-control signal from a user', is broad enough to read on the system processing the user's interactive ordering of a movie, in Garfinkle; see col. 3, lines 50-67 thru col. 4, lines 1-6 & col. 4, lines 51-65.

Considering claim 4, in Garfinkle if the lead-in segment is selected, then it is played from its beginning, which reads on the claimed subject matter, see col. 4, lines 12-35.

Considering claim 5, the claimed feature of, "ascertaining the temporal position of the particular program according to the schedule of programming", 'playing the counterpart to the particular program from substantially the same temporal position', 'so that the user perceives the transmission of the program to be substantially uninterrupted', is not taught by Garfinkle. However, Baker teaches that when using the VCR-like controls, (for instance Pause/Stop) the user is placed in a different stream (which corresponds with counterpart program) from the original transmission stream that most closely synchronizes with the temporal position of the original transmission, at the time of the Pause/Stop, see col. 13, lines 56-67 & col. 14, lines 39-67 thru col. 15, lines 1-10. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Garfinkle, detecting a position of a transmission of a movie in a first state, so that the user can receive the instant movie from essentially the same point in a second state, as taught by Baker, (col. 3, lines 15-30) at least for the desirable advantage of providing the user with full range of VCR-like controls such as Pause/Stop.

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Considering claims 6 & 19, Garfinkle (col. 3, lines 25-28; col. 3, lines 50-26) and Proehl (col. 5, lines 15-35), disclose the use of a wireless remote control.

Considering claims 7 & 24, the claimed feature of program-control manipulation of the counterpart is broad enough to read on the user starting the program in Garfinkle, (col. 3, lines 60-67 thru col. 4, lines 1-25 & col. 4, lines 45-65).

Considering claim 8, the claimed menu reads on Garfinkle, (col. 3, lines 25-67).

Considering claim 11, the claimed feature of transmitting the display of programs, from which the user can select at least one of the second set of programs', is met by the combination of Garfinkle col. 3, lines 40-67 & Proehl, (col. 6, lines 52-64; col. 7, lines 24-40; Fig. 9; Fig. 10).

Considering claims 13 & 14, the claimed features of 'playing a counterpart from its beginning' or 'playing a counterpart from a position defined for the particular program', which is broad enough to read on, 'from its beginning', correspond with subject matter mentioned above in the rejection of claim 4, and is likewise treated.

Considering claim 18, the claimed method steps that correspond with subject matter mentioned above in the rejection of claim 1, are likewise treated.

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Considering claim 23, the amended claimed method of distributing programming, comprises steps that correspond with subject matter mentioned above in the rejection of claims 1 & 5, and are likewise treated.

5. Claims 9-10, 12, 15 & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle, Proehl & Baker, further in view of Edwards, (U.S. Pat # 5,604,528).

Considering claims 9, 12, 15 & 20, Garfinkle does not discuss the claimed feature of verifying whether a user is authorized to access programs from a server. However Edwards, which is in the same filed of endeavor of VOD or pay-per-view services, teaches having CATV subscribers in at least two categories, with respect to premium channels, namely, regular subscription and periodic subscription. The subscribers with a periodic subscription are generally denied access to the premium channels, unless they sign up for a period of time, such as the weekend, or they are granted a promotional free period, Abstract; col. 4, lines 11-40; col. 10, lines 11-67 & col. 11, lines 1-40. Therefore, Edwards reads on determining whether a subscriber is authorized to access content; also see col. 18, lines 1-15. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Garfinkle with the feature of verifying user authorizations to access content, for the known purpose of ensuring that proper payments and are authorizations are given, before access to certain content, such as premium channels is provided to a particular user; see col. 1, lines 41-60; col. 2, lines 37-67.

Regarding claim 15, the instant claim additionally recites, 'transmitting promotional material describing access to programs from the server, if it is determined that the user is not authorized to access the server. The instant feature is met by the discussion in Edwards that system operators may provide free pay-per-view events or free previews as an incentive to get subscribers to pay for those services, col. 25, lines 5-64.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown



**HAI TRAN
PRIMARY EXAMINER**